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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/761,780      | 01/18/2001  | Ichiro Hashimoto     | 1614.1112           | 5963             |

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EXAMINER

JASMIN, LYNDY C

ART UNIT PAPER NUMBER

3627

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/761,780

Applicant(s)

HASHIMOTO ET AL.

Examiner

Lynda Jasmin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-7,9,13-15 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7,9,13-15 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on September 13, 2004 has been entered.

Amendment received on July 20, 2004 has been acknowledged. Claims 16 and 17 have been cancelled.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 3, 5, 9 and 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Shaffer et al. (6,748,426 B1).

Shaffer discloses a network-based server device embodied in a computer-readable recording medium containing a program for managing product inventory information on an individual-store basis including: a receiving unit (via merchant

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server) receiving requests for product information from a customer via a respective client device (consumer computer 14); and a processing unit (via information system 25) identifying inventory information of near stores having an address near an address designated by the customer (col. 11, lines 17-32), determined by comparing a postal code whose first predetermined number of digits are the same as corresponding, first predetermined number of digits of a postal code of the address designated by the customer (via comparing a Linkage Key to a linkage database in order to retrieve consumer data from a linkage database [see col. 5, lines 50-57; col. 6, lines 4-28]), and transmitting, to the client device in response to the request for product information, the identified product inventory information on an individual-store basis corresponding to the respective near stores selected on the basis of customer identification information received from the respective client device and sorting the transmitted product inventory information by store in order of proximity to the address designated by the customer (col. 11, lines 22-32). Further the transmitted product inventory information comprises access information for accessing individual stores (via valuable information items that vary by store and is only available at individual store level), hours of operation information for individual stores (via service and delivery time that vary by store), and the processing unit.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 6, 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer, in view of ServiceMerchandise.com (Business Wire Nov. 29, 1999).

Shaffer discloses the elements of the claimed invention, but fails to explicitly disclose adding identifying marks to the transmitting product inventory information and allowing the customer to place a hold on an item.

ServiceMechandise.com discloses the concept of providing online customer with the ability to see whether an item is in stock at local stores and

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reserve the item for pick-up. From this teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the linking information of Shaffer to include the holding or reserving of items based on store locator in order to facilitate an ease customer pick-up.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1, 9 and 18 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kargman et al. discloses linking a server software with a software and computer of each local store of a chain of stores or restaurants, whereby, not only are orders directly downloaded to the local store's computer system for storing orders in order to bypass live order-takers, but also provide for the uploading of the local store's menu and pricing.

Geary discloses selecting seller by zip code to select to nearest zip code.

Smith et al. discloses the concept of requesting nearest store to hold a particular product.

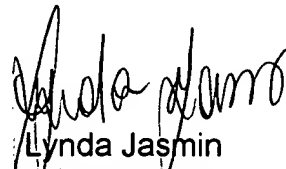
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Jasmin whose telephone number is

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(703) 305-0465. The examiner can normally be reached on Monday- Friday  
(8:00-5:30) alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the  
examiner's supervisor, Robert P Olszewski can be reached on (703) 308-5183.  
The fax phone number for the organization where this application or proceeding  
is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from  
the Patent Application Information Retrieval (PAIR) system. Status information  
for published applications may be obtained from either Private PAIR or Public  
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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-  
free).

  
Lynda Jasmin  
Primary Examiner  
Art Unit 3627  
11/13/04

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